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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,431	12/15/2003	Randall Woods	34024	3428

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ADVANCED MEDICAL OPTICS, INC.
1700 E. ST. ANDREW PLACE
SANTA ANA, CA 92705

EXAMINER

WILLSE, DAVID H

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/736,431

Applicant(s)

WOODS, RANDALL

Examiner

Dave Willse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3,6-20 and 36-45 is/are pending in the application.
- 4a) Of the above claim(s) 6-11, 17-20, 40 and 41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,3,12-16,36-39 and 42-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1-13-06; 3-13-06.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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In the Information Disclosure Statement of March 13, 2006, certain references were *not* considered because a concise explanation of the relevance (37 C.F.R. § 1.98(a)(3)) and/or a complete copy (37 C.F.R. § 1.98(a)(2)) and/or adequate information (in the case of the Thornton document; 37 C.F.R. § 1.98(b)(5)) was not presented.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 44 and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 44, line 1, "said posterior wall" lacks a proper antecedent basis. In claim 45, lines 2-3, "said initial thickness being at least about 1.2 times greater than said second thickness" directly contradicts the limitation "said optic initial thickness can be increased to a second thickness" (claim 45, lines 1-2).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 12, 16, 36, 37, and 42 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Payer, CH 681 687 A5: Derwent abstract; Figures 1-3. The connecting section 5

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of the optic positioning element clearly defines posterior and anterior faces, and the edge portion 4 of the optic positioning element possesses a bight. The shapes and dimensions of these surfaces are such that the intraocular lens 1 matches and fills the lens capsule, and thus these surfaces cooperate with one another and with the lens capsule to form a chamber within the optic positioning element and bounded by the posterior capsule. The optic 2 shape and thickness can be altered in response to changing forces applied to the optic via the force transmitting optical positioning element during the accommodation process (first five lines of the English abstract). Regarding claim 16, the Payer lens is *capable* of being radially compressively loaded into an appropriately sized lens capsule such that the optic “initial” thickness can decrease in response to ciliary body contraction, whether or not such was the intent.

Claims 13-15, 38, 39, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Payer, CH 681 687 A5. A second thickness being at least about 1.2 times greater than an initial thickness under a force of about 1-9 grams would have been obvious to the ordinary practitioner from the relatively low refractive indices associated with hydrogel and silicone materials, from the need to provide adequate accommodation for a diversity of patients, and from common knowledge about typical accommodation forces imparted by ciliary muscles. (A refractive index of at least about 1.36 would have been immediately obvious, if not inherent, in order to provide sufficient refraction for an optic intended to be contained within intraocular fluid.)

Claims 2, 3, 12, 14-16, 36-38, and 42-44 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hanna, WO 93/05733 A1 (corresponding to previously cited EP 0 766 540

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B1). Regarding claim 42 and others, attention is directed to the attached English translation: page 5, first paragraph. Regarding claims 2, 3, and 14: page 7, lines 17-20, of said translation.

Claims 13, 39, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanna, WO 93/05733 A1. The particular thickness changes would have been obvious to the ordinary practitioner from the curvature changes identified on page 9, lines 11-19, of said translation and from what is known about the lens capsule dimensions and stresses.

The Applicant's remarks have been considered and are addressed in the grounds of rejection as presented above. The new grounds of rejection were necessitated by added claims 43 and 44 (and the references must be fully applied: MPEP § 706.07). Therefore:

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is 571-272-4762. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Dave Willse
Primary Examiner
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